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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221951
Party	Defendant Hair Are Us, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

Geoffrey, LLC  
a Delaware limited liability  
company,

Opposer,

**OPPOSITION NO. 91221951**

**Serial No. 86222809**

v.

Hair Are Us, Inc.,  
a Georgia corporation  
Applicant.

**APPLICANT'S AMENDED ANSWER AND COUNTERCLAIM**

Applicant, Hair Are Us, Inc., for its amended answer to the Notice of Opposition filed by Geoffrey, LLC against application for registration of Hair Are Us, Inc.'s trademark HAIR ARE US, Serial No. 86222809 filed March 17<sup>th</sup>, 2014, and published in the Official Gazette of Apr 14, 2015, pleads and avers as follows:

1. Answering paragraph 1 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

2. Answering paragraph 2 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and

accordingly denies the allegations.

3. Answering paragraph 3 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

4. Answering paragraph 4 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

5. Answering paragraph 5 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

6. Answering paragraph 6 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

7. Answering paragraph 7 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

8. Answering paragraph 8 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

9. Answering paragraph 9 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and

accordingly denies the allegations.

10. Answering paragraph 10 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

11. Answering paragraph 11 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

12. Applicant admits the information contained in paragraph 12 of the Notice of Opposition.

13. Applicant admits the information contained in paragraph 13 of the Notice of Opposition.

14. Answering paragraph 14 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

15. Applicant denies the allegation contained in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegation contained in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegation contained in paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegation contained in paragraph 18 of the Notice of Opposition.

19. Answering paragraph 19 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

20. Applicant denies the allegation contained in paragraph 20 of the Notice of Opposition.

21. Applicant denies the allegation contained in paragraph 21 of the Notice of Opposition.

22. Answering paragraph 22 of the Notice of Opposition, Applicant denies “granting registration to Applicant would diminish and dilute the distinctive quality of Opposer’s rights in its famous R US Family of Marks...” Applicant further denies that it “...could also in the event of any mishaps involving, or poor quality of, the goods offered by Applicant, tarnish such distinctiveness”; as to the remaining allegations contained in the paragraph, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

23. Answering paragraph 23 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

24. Answering paragraph 24 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and

accordingly denies the allegations.


25. Answering paragraph 25 of the Notice of Opposition, Applicant denies that there is “a high degree of similarity between Applicant’s Mark and the TOYSЯUS Marks”; as to the remaining allegations contained in the paragraph, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

26. Applicant denies the allegation contained in paragraph 26 of the Notice of Opposition.


## **COUNTERCLAIM**

### **A. Background**

27. Pursuant to 37 CFR Section 2.106(b)(2) and Section 313 of the Trademark Trial and Appeal Board Manual of Procedure, the Applicant, Hair Are Us, Inc., by and through its undersigned counsel, files this counterclaim to cancel the mark of Opposer, Geoffrey, LLC, and avers as follows:

28. Applicant, Hair Are Us, Inc., is the owner of record of U.S. Ser. No. 86222809 for the mark HAIR ARE US, illustrated as  (referred herein sometimes as “Applicant’s Mark”). Applicant’s mark is used in connection with a commercial store, namely hair extensions; add-in and add-on hair accessories constructed primarily of synthetic and/or human hair in International Class 026, wherein said application having been filed in the U.S. Patent and Trademark Office on March 17, 2014.

29. Applicant’s application was published for opposition on April 14, 2015. Thereafter, Opposer filed an opposition against Applicant’s Mark. Opposer is the owner of

record of U.S. Reg. No. 3859458 for the mark  (referred herein sometimes as “TOYSRUS”) for “retail store and on-line retail store services” used in connection with International Class 35.<sup>1</sup>

## **B. Claim for Genericness**

30. A claim has facial plausibility when the Plaintiff pleads factual content that allows the Court to draw the reasonable inference that the Defendant is liable for the misconduct alleged. *Ashcroft v. Iqbal*, 555 U.S. 662, 678 (2009). Further, a claim is plausible on its face

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<sup>1</sup> Such registration was issued on October 12, 2010. The complete recitation of services in that registration is as follows:

Retail store and on-line retail store services all featuring toys, games, playthings, natural wooden toys, natural plush animals, organic cotton dolls, dolls, doll houses, doll accessories, doll house furniture, furniture, clothing, baby clothing, children's clothing, maternity clothing, outdoor toys, play sets, sandboxes, play swimming pools, swimming aids, pool rings, life jackets and arm floats for recreational use, outdoor play sets, sporting goods and equipment, roller skates, in-line skates, toy cars, toys trucks, toy airplanes, toy vehicle play sets, toy race tracks, toy action figures and play sets, toy activity tables for children with storage, toy boxes, board games, hand-held electronic games, puzzles, dolls, doll accessories, plush toys, educational toys, microscopes, telescopes, binoculars, science experiment kits, nature kits, magic sets, remote control vehicles and toys; retail store and on-line retail store services all featuring dress-up sets, Halloween costumes, books, cassettes, videos, CDs, DVDs, portable digital media players, musical instruments, toy musical instruments and microphones, computers, toy computers, educational computers, computer and video games, computer and video game consoles and accessories, home and car electronics, baby safety items, baby monitors, humidifiers, vaporizers, baby food and formula, food, beverages, and utensils; retail store and on-line retail store services all featuring diapers, medicine, skin and hair care products, bedding and room decor, baby furniture, children's furniture, adult furniture, rocking chairs, lamps, light fixtures, safety gates, safety night lights, rear view mirror attachments, car seats, high chairs, step stools, booster seats, carriages and strollers. retail store and on-line retail store services all featuring bicycles, tricycles, toy motorized vehicles, ride-on toys, playpens, portable playpens, baby travel systems, play yards and beds for children, bed linen, comforters, pillow cases, rugs, wall paper, swings and bouncers, diaper bags and carriers, bath products and bibs; retail store and on-line retail store services all featuring, pens, paper, crayons, stationery, school supplies, artist supplies, stickers, coloring books, puzzle books, knapsacks, school bags, sports bags, gift cards and gift wrap; gift registry services.

The registration includes the statement that “[t]he mark consists of the words ‘TOYSRUS’ with a backwards letter ‘R’ in blue with a white star design in the center with the letter ‘T’ in red, the letter ‘O’ in orange, the letter ‘Y’ in green” the letter ‘S’ in red, the letter ‘U’ in green and the letter ‘S’ in red.” The registration also includes a statement that “[t]he color(s) red, orange, green, blue and white is/are claimed as a feature of the mark.”

when the Plaintiff pleads factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that, the Petitioner has standing and that a valid ground for cancellation exists. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007).

31. A generic term is common descriptive name of a class of goods or services. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are incapable of being source indicators, and are therefore, unregistrable on both the Principle Register under Trademark Act Section 2(f), 15 U.S.C. 1052(f), and the Supplemental Register. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2D 1827, 1830 (Fed. Cir. 2015); *See Also In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ 2d 1378 (Fed. Cir. 2007). When a registered term is generic for one or more of goods or services identified in a registration, that registration may be cancelled in its entirety. *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988). Where the term at issue identifies goods that are a primary or central focus of the retail store [emphasis added] or distributorship services, the Board has generally found that term to be generic. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009).

32. The critical issue in determining if a mark is generic is whether the record shows that members of relevant public primarily use or understand the term sought to be registered [or registered] to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, at 990.

33. Furthermore, in order to determine if a mark is generic, a two-part test is required: (1) what is the genus of goods or services at issue? and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? *Id.*



### **C. Primary Significance to the Relevant Public**

#### **i. Definitions According to Tangible Sources**

34. Applicant asserts that Opposer's mark is generic because the record clearly shows that members of relevant public primarily use or understand Opposer's mark to refer to a category or class of goods and/or services in question.

35. Applicant emphasizes that evidence from relevant public's understandings of a mark can be obtained through tangible sources. *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985) (stating that evidence of the relevant public's understanding could be obtained from dictionaries, newspapers, magazines, trade journals and other publication). Dictionary definitions are considered by the board through judicial notice. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *See Also In Re Mens Fitness Unlimited, LLC*, SERIAL 76640536, 2010 WL 3597244 (Aug. 30, 2010) (the Board broke down "Fitness Sneaker" using the dictionary definition of each word to prove that the phrase is generic). Dictionary definitions alone may support a genericness refusal [emphasis added]. *In re Wm. B. Coleman Co., Inc.* 93 U.S.P.Q.2d 2019 (P.T.O. Mar. 4, 2010).

36. Collins English Dictionary, 5th Edition, defines "TOY" as an object designed to be played with. It defines the component "Я" as referenced by its phonetic version "ARE" as an intransitive verb meaning "BE" and "US" as a pronoun of "WE." Accordingly, the term "ЯUS" is simply a phonetic version of a generic term "WE ARE" to denote a contextual relation with a subject matter immediately preceding it, which is "TOYS".

37. Definitions, when taken separately, persuasively suggest that the mark is understood as generic by the consuming public and the definitions should be given significant

weight. *See Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*, 198 F.3d 1143 (9th Cir. 1999). Based on aforesaid definitions, Opposer’s “TOYS” component of the mark defines objects to be played with and the “ЯUS” component defines “WE ARE.” As such, when “TOYS” and “ЯUS”, even when taken separately, persuasively suggest that TOYSЯUS is understood as a generic term by the relevant consuming public. *Id.*

38. When taken as a whole, collectively, in commercial context, as understood by the relevant public, the designation “TOYSЯUS” means a “retail store/online retail store services, all featuring toys and other playthings” or simply put, “Toy Store” for toys and other similar playthings designed to be played with. *See, e.g., In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970)(CUSTOMBLENDED generic for gasoline); *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969)(PASTEURIZED generic for face cream); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998)(ATTIC generic for automatic sprinklers for fire protection); and *In re Computer Store, Inc.*, 211 USPQ 72 (TTAB 1981)(THE COMPUTER STORE generic for retail store for computers).

## **ii. Genus of Goods and Services**

39. Opposer’s mark is generic because it identifies the genus of its services as a toy store and the relevant public understands that the designation “TOYSЯUS” primarily refers to that genus of services as a retail store selling toys, or simply put, a toy store.

40. The genus is appropriately defined by the description of goods and services recited in the registration. *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638 (Fed. Cir. 1991) (“[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the certificate of registration.”). Here, Opposer identifies the Genus of its services as a toy store in the mark’s registration as follows: “retail store and on-line retail store services all featuring toys,

games, playthings, natural wooden toys...”

41. Generally, when the matter sought to be registered identifies goods or services that are a primary or central focus of the store or distributorship service, such as “toys” for a toy store, that term is considered generic. *In Re Cordua Restaurants Lp*, 110 U.S.P.Q.2d 1227 (P.T.O. Mar. 24, 2014). A term that identifies a genus of goods or services associated with the related goods or services does not even get a supplemental registration and is considered generic. *In re Meridian Rack & Pinion DBA buyautoparts.com*, 114 USPQ2d 1462 (TTAB 2015).

42. Similarly, when the mark identifies the goods that are the primary or central focus of the retail store, the term is deemed generic - “TOYS” for a toy store. The genus of goods and/or services is often defined by the applicant’s identification of goods and/or services. *Id*; *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 (TTAB 2002) (BONDS.COM is generic for “providing information regarding financial products and services via a global computer network and providing electronic commerce services via a global computer network ... with respect to taxable and tax exempt debt instruments” because the services encompass information about bonds); *Hotels.com*, 573 F.3d 1300, 91 USPQ2d at 1535 (HOTELS.COM is generic where hotels were the focus of and named a key aspect of the information and reservation services in the application); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2027 n.2 (TTAB 2010); *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, conducted via the Internet); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture, and jewelry); *In re Log Cabin*

*Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services).

### **iii. Use of Generic Words in Commerce**

43. Within the commercial context, the phrase “R Us” is simply saying “you can buy a certain product here in our store, as this is what we sell.”

44. Beyond the commercial context, it is not uncommon to see the “R Us” phrase being utilized to symbolize something that a group or individual identifies so closely with to describe himself or herself.

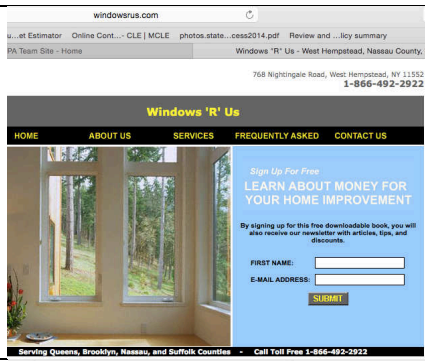
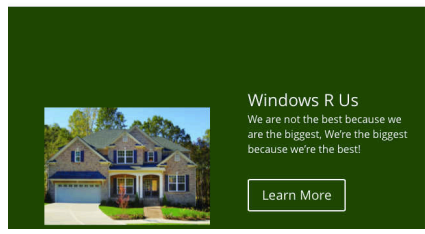

45. In addition to the dictionary definitions, there is internet examples, which amply demonstrate that there are numerous commercial businesses utilize versions of “R Us” in connection with their goods and services for their consumers. As of August 2015, a Google search for “R Us” (parenthesis included in search term) returned over 5,910,000 hits with pages after pages of search results listing businesses and other groups using the “R Us” phrase. Evidence of other company’s using the phrase “R Us” is evidence it’s generic, associating primarily with a service rather than a source. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008). Such widespread commercial usage indicates that the relevant public commonly understands the term “R Us” to apply to stores that specialize in selling a particular category of products. The primary significant of the term “R Us” is thus a generic denotation of a


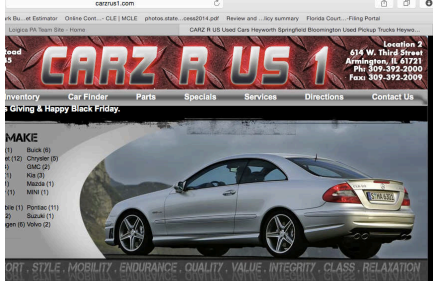

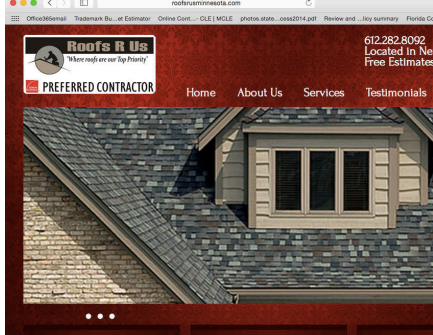

particular type of retail store. *See Golf Warehouse, L.L.C. v. Golfer's Warehouse, Inc.*, 142 F. Supp. 2d 1307, 1312 (D. Kan. 2001) (Such widespread retail usage indicates that the relevant public commonly understands the term “warehouse” to apply to retail stores that sell a wide variety of products. When members of the relevant public consider the term “warehouse” in the retail environment, they generally expect high volume, discount prices, and a relatively large, sparsely decorated store. The primary significance of the term “warehouse” is thus a generic denotation of a particular type of retail store).

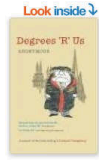
46. Similar Marks Recognized by the USPTO & Current Applications:

<u>Mark</u>	<u>Status, Reg. or Ser. No</u>	<u>Abbreviated Goods Services</u>	<u>Class</u>
<b>BENRUS</b>	Registered – Reg. No. 3882293	Blank journals; Envelopes for stationery use; Paper stationery;	014
<b>FISHINGURUS</b>	Registered – Reg. No. 4012425	Retail store and on-line retail store services featuring fishing gear...	035
<b>FASTRUSS</b>	Registered – Reg. No. 3936539	Custom design and engineering of prefabricated light gauge steel trusses and wall panels	042
<b>PERFECT AS U ARE</b>	Registered – Reg. No. 4637112	Clothing, namely, women's shirts, shorts and socks.	025
<b>GIFTCARDSRUS</b>	Serial No. 86297262	Procurement, namely, purchasing gift cards for others.	035
<b>WE ARE HERE WHEN YOU NEED US</b>	Serial No. 86451688	Pediatric Medical Services	044
<b>TRY US, WE'RE FUN-UGLY</b>	Serial No. 86415554	fresh fruits and vegetables.	31

47. Third Party Examples “R Us” use from Google Searches:

<u>Name</u>	<u>Product and/or Service</u>	<u>Website Source and Notes</u>	<u>Actual Use in Commerce Website Image/</u>
<b>Windows R Us, New York</b>	Windows and Window Installations	<a href="http://www.windowrus.com">http://www.windowrus.com</a> We are a family owned and operated business. We are licensed in New York City, Nassau and Suffolk counties.	
<b>Windows R Us, Pennsylvania</b>	Windows and Window Installations	<a href="http://windowruspittsburgh.com">http://windowruspittsburgh.com</a> Windows R Us is based in Pittsburgh, PA and holds dear to the true family values that make Pittsburgh so special. They have locations in Castle Shannon, PA; Canonsburg, PA; at the Southpointe Iceoplex	
<b>Camps R Us,</b>	Summer Camps for Children	<a href="http://www.campsrus.org">http://www.campsrus.org</a> Owned by Camps 'R' Us, New York LLC	

<b>Goats R Us</b>	Alternative weed eradication and lawn services.	<a href="http://www.goatsrus.com">http://www.goatsrus.com</a> Goats R Us is a family owned and operated grazing company. Established in 1995, our livestock are used primarily for fuel mitigation and the eradication of	
<b>Carz R Us</b>	Retail Car Sales	<a href="http://www.carzrus1.com">http://www.carzrus1.com</a> Search Used Cars In Heyworth At Carz R Us To Find The Best Cars Heyworth, Springfield, Bloomington, Armington, IL	
<b>Barks R Us</b>	Animal Rescue Services	<a href="http://awos.petfinder.com/shelters/WA193.html">http://awos.petfinder.com/shelters/WA193.html</a> Pet shelter and adoption service.	
<b>Roofs R Us</b>	Roofing Services	<a href="http://roofsrusminnesota.com">http://roofsrusminnesota.com</a> At Roofs R Us, we specialize in your roofing needs. New Brighton, MN	
<b>Shirts R Us</b>	Customized Shirt Printing	<a href="http://www.shirtsrus.biz">http://www.shirtsrus.biz</a> Ft. Lauderdale Florida	

<b>Degrees R Us</b>	Paperback Comedy Book sold in Amazon.com	<a href="http://www.amazon.com/Degrees-R-Us-Anonymous/dp/0954758692">http://www.amazon.com/Degrees-R-Us-Anonymous/dp/0954758692</a>	 <p>Degrees 'R' Us Paperback – September 1, 2007 by Anonymous (Author) ★★★★★ 1 customer review</p> <p>See all 2 formats and editions</p> <p>Kindle \$1.99 Read with our free app</p> <p>Paperback \$9.99 <i>Prime</i> 7 Used from \$1.80 13 New from \$8.26</p> <p>See the Best Books of 2014 Our editors' favorites in Fiction, Mystery, Romance, Cookbooks, Children's books, and more. <a href="#">Learn more</a></p> <p>In this sequel to the best-selling "A Campus Conspiracy" there is</p>
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#### 48. Third Party Use of “R Us” Examples from Business Entities and Retail Stores

Registered with Secretary of State Departments Across the Country:

<u>Name</u>	<u>State Department</u>	<u>Notes or Identification Number</u>	<u>Active/Inactive</u>
<b>AQUARIUMS R US</b>	California Secretary of State	C3076306	Active
<b>AUTOS R US INC</b>	California Secretary of State	C3200122	Active
<b>BAKE R US INC</b>	California Secretary of State	C1787569	Active
<b>BARGAINS R US INC</b>	California Secretary of State	C3631814	Active
<b>BITS R US INC</b>	California Secretary of State	C2136284	Active
<b>BOXES R US INC</b>	California Secretary of State	C2214950	Active
<b>BUSES R US INC</b>	California Secretary of State	C3291318	Active
<b>CHOICES R US</b>	California Secretary of State	C2378398	Active
<b>EARS R US INC</b>	California Secretary of State	C3599172	Active
<b>FOODS R US INC</b>	California Secretary of State	C2045116	Active
<b>GOLD R US INC</b>	California Secretary of State	C3559897	Active
<b>FIELDS R US INC</b>	California Secretary of State	C3540435	Active
<b>FILMS R US INC</b>	California Secretary of State	C1373724	Active
<b>FREIGHTS R US</b>	California Secretary of State	C2315492	Active
<b>GREENS R US INC</b>	California Secretary of State	C3570603	Active



<b>HOMES R US REALTY INC</b>	California Secretary of State	C2637912	Active
<b>HYDRO R US INC</b>	California Secretary of State	C3447667	Active
<b>INTERPRETE S R US INC</b>	California Secretary of State	C2358073	Active
<b>INVESTMENTS R US INC</b>	California Secretary of State	C2536142	Active
<b>BUBBLES R US INC</b>	NYS Department of State Division of Corporations	2611412	Active
<b>BUGS R US</b>	NYS Department of State Division of Corporations	3862502	Active
<b>BROKERS R US</b>	NYS Department of State Division of Corporations	4268957	Active
<b>CONSTRUCTION R US</b>	NYS Department of State Division of Corporations	TBD	Inactive
<b>PEOPLE ARE US, INC.</b>	NYS Department of State Division of Corporations	2382257	Active
<b>CAKES R US</b>	NYS Department of State Division of Corporations	3965410	Active
<b>LENS R US</b>	NYS Department of State Division of Corporations	3872785	Active
<b>PRINT R US INC</b>	NYS Department of State Division of Corporations	3562310	Active
<b>STUDIO R US</b>	NYS Department of State Division of Corporations	3639671	Active
<b>POOLS R US INC</b>	NYS Department of State Division of Corporations	2109972	Active
<b>PHONES R US</b>	NYS Department of State Division of Corporations	4534006	Active
<b>WINDOWS R US</b>	NYS Department of State Division of Corporations	796722	Active
<b>WHEELS R</b>	NYS Department of	1967747	Active

<b>US INC</b>	State Division of Corporations		
<b>PRODUCTS R US</b>	Florida Dept. of State Division of Corporations	P03000102121	Inactive
<b>BOATS ARE US, INC.</b>	Florida Dept. of State Division of Corporations	L15635	Inactive

49. Third Party Use of “R Us” Mark Examples from Businesses and Retail Stores

Listed with The Yellow Pages in Delaware, Florida, Illinois, and Georgia:

<u>NAME</u>	<u>STATE</u>	<u>TELEPHONE</u>	<u>SOURCE</u>
<b>Cuts R US</b>	Delaware	302-6742223	Yellow Pages
<b>Heads R US</b>	Delaware	302-5358263	Yellow Pages
<b>Doors R US</b>	Delaware	302-6977741	Yellow Pages
<b>Ducts R US</b>	Delaware	302-2844006	Yellow pages
<b>Shirts R US</b>	Florida	954- 5334695	Yellow Pages
<b>Computers R US</b>	Florida	904- 7710199	Yellow Pages
<b>Cool R US</b>	Florida	904- 7017848	Yellow Pages
<b>Dumpsters R US</b>	Florida	888-2941724	Yellow Pages
<b>Ceilings R US</b>	Florida	954- 4520004	Yellow Pages
<b>Screens R US</b>	Florida	813- 2951217	Yellow Pages
<b>Phones R US</b>	Florida	786- 3694865	Yellow Pages
<b>Signs R US</b>	Florida	941- 5850480	Yellow Pages
<b>Nails R US</b>	Florida	904- 9926957	Yellow Pages
<b>Bike R US</b>	Florida	850- 8376947	Yellow Pages
<b>Trees R US</b>	Illinois	331-5518000	Yellow Pages
<b>Tows R US</b>	Illinois	8476763300	Yellow Pages
<b>Maids R Us</b>	Illinois	217-3038424	Yellow Pages
<b>Furniture R US</b>	Illinois	773- 5830417	Yellow Pages
<b>Limos R US</b>	Illinois	773- 7929380	Yellow Pages
<b>Computer &amp; Electronic R US</b>	Illinois	630- 7170018	Yellow Pages
<b>Printing R US</b>	Illinois	847-9561433	Yellow Pages
<b>Fish R US</b>	Illinois	815- 2733277	Yellow Pages
<b>Repairs R US</b>	Georgia	770- 9725090	Yellow pages
<b>Luv R US</b>	Georgia	404-2896619	Yellow Pages
<b>Colors R US</b>	Georgia	770- 7180039	Yellow pages

<b>Pampered Pets R US</b>	Georgia	229- 8906861	Yellow Pages
<b>Eye's R US</b>	Georgia	770- 4369123	Yellow Pages
<b>Leaks R US</b>	Georgia	770- 3890305	Yellow Pages
<b>Dumpsters R US</b>	Georgia	800- 5095399	Yellow Pages
<b>Storage R US</b>	Georgia	912- 4891990	Yellow Pages
<b>Weddings R US</b>	Georgia	912- 3682007	Yellow Pages
<b>Design R US</b>	Georgia	770- 3064765	Yellow Pages

The examples of record make it both clear and substantial and demonstrate that the term “R US” has a commonly understood meaning to the public as referring to “We are a retail store or a service company that sells \_\_\_\_\_ (name of goods or services).

**B. Mark as a Whole is a Common Descriptive Name (Generic) of a Class of the Services at Issue**

50. The *Gould* standard, is used to evaluate combined words, when components of a tradename are generic, a combination of such words retain that generic quality. *Best Buy Warehouse v. Best Buy Co.*, 751 F. Supp. 824, 825 (W.D. Mo. 1989) aff'd, 920 F.2d 536 (8th Cir. 1990); *In re Gould Paper Corp.*, 834 F.2d 1017 (Fed. Cir. 1987). The *Gould* standard is used whenever there is a union of words, notwithstanding the space between it's component terms. *In Re Michael Weinberger*, 77915887, 2011 WL 1576728, at \*2 (Apr. 14, 2011) (holding that spaces do not disqualify two words from being scrutinized under the *Gould* standard). TOYSЯUS, which is a combination of words, is composed of three words, namely, Toys, Я, and Us. Since the components of TOYSЯUS are generic, the terms retain their generic quality when these three words, Toys, Я, and Us are combined.

53. For the same reasons that trademark law does not grant protection to generic words or phrases, it also does not extend protection to a generic component of a trademark. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008). Similarly, trademark protection does not extend protection to one or more generic components of a

trademark, for example, Toys, Я, and Us (See dictionary definitions and identification of goods and services in Opposer's registration.).

54. Moreover, merely combining two or more words does not render a mark the protection of a trademark. *In Re Mens Fitness Unlimited, LLC*, SERIAL 76640536, 2010 WL 3597244 (Aug. 30, 2010); *In Re Difillippo*, 85013002, 2014 WL 7496053, at 15 (Dec. 17, 2014). TOYSЯUS has simply joined a plurality of most pertinent and individually generic terms, applicable to its services, and then attempted to appropriate the ordinary compounded terms TOYSЯUS to form a trademark. In this instance, the terms TOYSЯUS remains as generic in the compound, as individually Toys, Я, and Us, and the compound thus creates itself as generic. *See Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 53 CCPA 1167, 149 USPQ 559 (1966)(“TURBODIESEL” generic for engines having exhaust driven turbine superchargers); *In re Abcor Dev. Corp.*, 588 F.2d 811, 815, 200 USPQ 215, 219 (CCPA 1978)(“GASBADGE” generic for a gas monitoring badge); and *In re Noon Hour Food Products, Inc.*, 88 USPQ2d 1172 (TTAB 2008) (BOND-OST held generic for cheese).

55. Accordingly, even when Applicant's generic components of the mark are taken as a whole, the term TOYSЯUS is generic for “a store selling toys” or simply put, a toy store. *See In Re Difillippo*, 85013002, 2014, WL 7496053, at 15 (2014) (holding that Applicant's proposed mark SHRIMP COTIJA SPRING ROLLS simply names specific goods included within its genus, namely, spring rolls with shrimp and cotija); *Golf Warehouse*, 142 F. Supp. 2d 1307, 1312 (D. Kan. 2001) (holding that GOLF WAREHOUSE was simply a high volume discount price, relatively large, sparsely decorated store selling products related to golfing.).


56. Additionally, in order to determine if a mark is generic, the “Who-are-you/What-are-you” test must be used. A non-generic mark answers the buyer's following questions: who

are you; where do you come from; and who vouches for you. But the generic name of the product answers the question, “What are you?” *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 929 (9th Cir. 2005). Applicant’s mark does not answer the questions “who are you”, “where do you come from”, and “who vouches for you.” Rather, applicant’s mark unequivocally answers the question “what are you.” The answer to this question is that it is a retail store that specializes in selling toys or simply put, a toy store. *See Advertise.com, Inc. v. AAOL Advert., Inc.*, 616 F.3d 974, 978 (9th Cir. 2010) (applying the who-are-you/what-are-you test to determine that ADVERTISING.COM is generic). Furthermore, when Applicant’s “toys” component of the mark is replaced with other nouns, it is readily apparent how the mark only answers the question, “What are you?” For example, Books R Us answers the question “what are you selling” with books; Clothes R Us answers the question “what are you selling” with clothes; Shoes R Us answers the question “what are you selling” with shoes; and Furniture R Us answers the question “what are you selling” with furniture, and so forth.

57. A generic term is one whose “primary significance ... to the relevant public is an identifier of the nature of goods or services, rather than its source and because they service primarily to describe products rather than identify their sources, generic terms are incapable of becoming trademarks, at least in connection with the products that they designate. *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925 (9th Cir. 2005); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008). Because TOYSRUS is merely conveying to the relevant public that it is a retail store selling toys, or simply put, a toy store, it clearly identifies the nature of the goods or services, rather than its source, and thus, is a generic term.


### **C. Stylization and Design Element Does Not Create Separate Commercial Impression**

58. TOYSЯUS as a whole is a common descriptive name (generic) of class of the services at issue. The stylization of that term and design element as set forth in Opposer's registration does not create a separate commercial impression over and above that made by the generic term. *See H. Marvin Ginn Corp.* 228 USPQ at 530; *In re Sadoru Group, Ltd.*, \_\_ USPQ2d \_\_, Ser. No. 77941164 (TTAB 2012)(finding the stylization of SADORU does not create a separate and inherently distinctive commercial impression apart from the word itself); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009); *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980). TOYSЯUS comprises entirely of generic wording, and either the entire mark or some of the terms are the phonetic equivalent of the generic wording [emphasis added]. Such marks cannot be approved for registration even on the Supplemental Register. *See TMEP* §1209.01(c).

59. Stylization and coloring of the lettering does not create a separate and inherently distinctive commercial impression apart from the words themselves. *In Re Dr. Harold Katz, LLC*, 86076435, 2015 WL 6746552, at 7 (2015) (holding that the  mark, consisting of merely generic words depicted in stylized format, even with color scheme and stylization did not create a separate and inherently distinctive commercial impression apart from the words themselves); *In re Sutkowski and Washkuhn Ltd.*, \_\_ USPQ2d \_\_, Ser. No. 75643089 (TTAB 2002)(finding that lettering in Applicant's mark, and the fact that the word BUSINESS is shown in blue color coupled with the words LAW FIRM shown in a stylized font, collectively, do not make the stylization highly unusual enough to make a striking commercial impression). Similarly, TOYSЯUS has stylization and coloring in its mark, that does not render the mark highly unusual stylistically. Specifically, it does not create separate and inherently distinctive

commercial impression over and above that made by the generic term TOYSЯUS, which means nothing more than a generic term TOY STORE. *Id.*; *In Re Dr. Harold Katz, LLC*, 86076435, 2015 WL 6746552, at 7.

60. Similarly, the backwards “Я” does not create a separate commercial impression over and above that made by the generic term TOYSЯUS because it is simply a transposition of a letter. *See In re Vasco Metals Corp.*, 154 USPQ 191 (TTAB 1967) (noting that the mere transposition of words is generally insufficient to create trademark rights).

61. Furthermore, common basic shapes, such as circles, ovals, triangles, diamonds, stars, and other geometric figures, when used in printed matter are not regarded as origin indicators for goods or services. *See Permatex Company, Inc. v. California Tube Products, Inc.*, 175 USPQ 764 (TTAB 1972). Specifically, a star symbol is not considered inherently distinctive. *Amazing Spaces Inc. v. Metro Mini Storage*, 608 F. 3d 225 (5th Cir. 2010) (holding the star shape symbol  is not inherently distinctive). Likewise, the star symbol within the backwards letter “Я” in the Opposer’s mark in question is merely a basic shape that is not an origin indicator and is not inherently distinctive. *Id.*; *Permatex*, 175 USPQ 764; *Wiley v. Am. Greetings Corp.*, 762 F. 2d 139, 142 (1st Cir. 1985) (holding that a basic shape, such as a red heart shape on a teddy bear is an “ordinary geometric shape” because it “carried no distinctive message of origin to the consumer”); *I.P. Lund Trading*, 163 F.3d at 40 (commonplace symbols and designs are not inherently distinctive, since their appearance on numerous products makes it unlikely that consumers will view them as distinctive of the goods or services of a particular seller).

62. The star symbol in the transposed Я coupled with the basic coloring of words of the Opposer’s mark does not create a separate distinct commercial impression over and above

that made by the generic terms TOYSЯUS – its ordinary stylization and design elements carry no distinctive message of origin to the consumer. In other words, the design elements of the Opposer’s mark and the stylization as set forth in Opposer’s registration does not create a separate commercial impression over and above that made by the generic term.

**D. Conclusion**

63. Therefore, because TOYSЯUS is generic for a toy store since it self identifies the genus of goods at issue and the relevant public understands the designation primarily to refer to TOYSЯUS simply as a retail store for toys, or simply put, as a toy store, Opposer’s mark should be canceled.

Therefore, the Applicant prays that the Notice of Opposition shall be dismissed with prejudice and Applicant/Cancellation Petitioner also respectfully requests that U.S. Reg. No 3859458 be cancelled.

Respectfully submitted,  
Hair Are Us, Inc.

Dated: 01/29/2016

By: /Harry Tapias/  
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**CERTIFICATE OF SERVICE**

I hereby certify that this correspondence has been electronically delivered to the Trademark Trial and Appeal Board via their Electronic Filing System within the twenty day time period from the mailing date set forth in the Board's order, on this 29<sup>th</sup> day of January, 2016 addressed to the following:

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**/Harry Tapias/**  
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**CERTIFICATE OF SERVICE**

I hereby certify that I have on this 29<sup>th</sup> day of January, 2016, emailed the foregoing AMENDED ANSWER AND COUNTER-CLAIM to the following:

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